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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,855	10/18/2006	Kenji Otda	49288.1600	4197
2022 7590 07/09/2010 SNELL & WILMER L.L.P. (Main) 400 EAST VAN BUREN ONE ARIZONA CENTER PHOENIX, AZ 85004-2202				
EXAMINER DENTER, CLARK F				
ART UNIT		PAPER NUMBER		
3724				
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07/09/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/554,855

**Applicant(s)**

OTODA ET AL.

**Examiner**

Clark F. Dexter

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-32, 35-48, 53, 54, 56-79 and 84-96 is/are pending in the application.  
4a) Of the above claim(s) 5, 6, 8-28, 31, 36-48, 53, 54, 56-79 and 84-96 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4, 29, 30, 32 and 35 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed on April 10, 2010 has been entered.

#### ***Specification***

2. The disclosure stands objected to because of the following informalities:

In paragraph 00171, line 2, it seems that "7" should read --6--.

In paragraph 00172, line 2, it seems that "7" should read --6--.

In paragraph 00174, line 2, it seems that "8" should read --7--.

Between paragraphs 00363 and 00364, the title "Embodiment 6" is unclear as to what it refers since there appears to be no specifics directed to such an embodiment, and wherein the two paragraphs that follow this title are directed to previous embodiments.

In paragraphs 00364 to the end of the specification, the references to the embodiments are unclear since the specification describes embodiments of the invention including embodiments 7 and 8 but there is no specific description of an embodiment 6.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

3. Claims 1-4, 29, 30, 32 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 9, the recitation "in view of the width direction" is vague and indefinite as to what is being set forth (i.e., does applicant intend the view to be taken from the width direction, in other words "as viewed in the width direction?"), and further the recitation "the width direction" lacks antecedent basis.

In claim 29, lines 3-4, the recitation "wherein the pressing means such that the pressing means" is vague and indefinite as to what is being set forth.

In claim 30, line 4, the recitation "the scribing apparatus further comprising the brittle substrate cutting system" is vague and indefinite as to what is being set forth, particularly since the claim previously sets forth the opposite and since the scribing apparatus is disclosed as part of the brittle substrate cutting system (not vice versa).

In claim 32, line 13, the recitation "in view of the width direction" is vague and indefinite as to what is being set forth (i.e., does applicant intend the view to be taken from the width direction, in other words "as viewed in the width direction?").

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 29 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Le Gras, pn 3,259,286.

Le Gras discloses a cutting system as follows:

a breaking apparatus (e.g., 12) for breaking a brittle substrate along a scribing line,

wherein the breaking apparatus includes a pressing means (e.g., 20) for pressing a second surface of the brittle substrate, and a first holding means (e.g., 14) for holding

a first surface of the brittle substrate, wherein the pressing means moves along the scribing line while the pressing means presses the second surface of the brittle substrate opposing the first surface of the brittle substrate with the first surface of the brittle substrate is being held by the first holding means, and wherein the pressing means is formed in the shape of an arc in view of the width direction (e.g., as viewed in Fig. 4, 20 is clearly formed in the shape of an arc),

wherein a groove section (e.g., 25) is formed in the pressing means such that the pressing means does not contact with a line on the second surface of the brittle substrate, the line opposing the scribing line;

[claim 2] wherein the pressing means moves along the scribing line while the first holding means and the pressing means oppose each other with the brittle substrate therebetween (e.g., as described in col. 4, lines 50-52);

[claim 3] wherein the pressing means rolls along the scribing line;

[claim 4 (from 3)] wherein the pressing means is a roller (e.g., 20);

[claim 29] further comprising a scribing apparatus including a scribing line forming means (e.g., 11) for forming a scribing line in the first surface of the brittle substrate, wherein the pressing means such that the pressing means moves along the scribing line while the first holding means and the pressing means oppose each other with the brittle substrate therebetween and while the scribing line forming means forms the scribing line on the first surface of the brittle substrate;

[claim 30] wherein a scribing apparatus comprises a scribing line forming means (e.g., 11) for forming the scribing line on the first surface of the brittle substrate while the

first surface of the brittle substrate is held, the scribing apparatus further comprising the brittle substrate cutting system (e.g., as best understood); and

the scribing line forming means further comprises a pressing means for pressing the second surface opposing the first surface of the brittle substrate.

***Claim Rejections - 35 USC § 103***

7. Claims 32 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Le Gras, pn 3,259,286.

Le Gras discloses an apparatus with almost every structural limitation of the claimed invention but lacks a second occurrence of the corresponding structure of the apparatus. It is noted that Le Gras discloses the structure set forth in these claims in the same manner as described above for claim 1 and the corresponding dependent claims. However, the Examiner takes Official notice that it is old and well known in the art to treat multiple portions of a workpiece simultaneously or serially to efficiently machine a workpiece; for example, to conserve time and space. Therefore, it would have been obvious to one having ordinary skill in the art to provide additional cutting such breaking/cutting on or with the structure of Le Gras to make additional cuts simultaneously and/or serially to gain the well known benefits including those described above.

***Response to Arguments***

8. Applicant's arguments filed April 10, 2010 have been fully considered but they are not persuasive.

In the third paragraph on page 18 of the subject response, applicant argues that the specification is sufficiently clear and accurate. However, the Examiner respectfully disagrees and maintains the position that the specification is not sufficiently clear. The problem appears to lie in the fact that there appears to be no embodiment 6 disclosed. that is, while "embodiment 6" is recited in the disclosure (see the objections above), no specific description of such an embodiment appears to be disclosed. Thus, there appears to be only 7, not 8, embodiments, and it seems that the specification should be amended accordingly.

In the second paragraph on page 19 of the subject response, applicant argues that Le Gras "does not disclose or contemplate at least "wherein the pressing means is formed in the shape of an arc in view of the width direction," as recited by independent claim 1." The Examiner respectfully disagrees. As shown in the figures of Le Gras, particularly Fig. 4, the pressing means of Le Gras, feature 20, clearly is arcuate taken in this width direction.

Thus, it is respectfully submitted that for at least the reason described above, the rejections including the prior art rejections must be maintained.



***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
July 6, 2010